



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Ken HIRUNUMA et al.

Group Art Unit : 2872

Appl. No. : 10/700,496

Examiner : PRITCHETT, J.

Filed : November 5, 2003

Confirmation No. : 6278

For : DIGITAL-CAMERA-PROVIDED BINOCULARS

REPLY BRIEF UNDER 37 C.F.R. §41.41

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief- Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Examiner's Answer dated April 14, 2006, to the Appeal Brief filed March 13, 2006, Appellants submit the present Reply Brief.

Appellants maintain that each reason set forth in the Appeal Brief filed March 13, 2006 for the patentability of the pending claims is correct and again respectfully request that the decision of the Examiner to reject claims 1-7 be reversed and that the application be returned to the Examining Group for allowance.

REMARKS

It is respectfully submitted that the Appeal Brief filed March 13, 2006, has fully addressed the requirements for patentability of the pending claims. Accordingly, the herein-contained remarks are merely supplemental to the Appeal Brief filed on March 13, 2006, and all previously-proffered arguments in this Brief are incorporated herein. In order to facilitate review of this Reply Brief and for the sake of brevity, the present remarks do not include a discussion of all rejected claims or points raised by the Examiner, and such is not to be considered an acquiescence to the Examiner's rejections or remarks.

On page 6 of the Examiner's Answer, the Examiner asserted that "the 'bottom surface' of claim 1 is not provided with a point of reference, therefore the bottom face could be reasonably interpreted as *any* of the faces of the binocular assembly" (emphasis added)" and that "the claim language is broad to the point that if a user of the Wu reference merely picked up the WU binoculars with the microphone on the bottom surface the current application, if allowed, would be infringed." Applicant submits that one skilled in the art would readily understand that a "bottom surface" as recited on claim 1 would include a surface shown in Fig. 4 of the present application, and that (Since WU is silent as to the positional relationship of the binoculars of Fig. 1) the binoculars are shown in its intended upright position (in relation to the user's face). Appellants further again submit that mere assertions cannot change realities, and thus merely turning an object upside down does not make the bottom surface the top surface, and vice-versa.

For example, if the Examiner were to turn the WU device around to take a self-portrait, the front end does not become the back end, and vice-versa.¹

The Examiner also noted that "the WU reference shows no ergonomic bend to the binocular device (Fig. 1) which would necessitate for comfort a top surface or bottom surface of the WU reference." The Examiner is correct in his assertion that no ergonomic bend is shown in Fig. 1 of WU. In this regard, Appellants note that in Fig. 1 (the only figure showing the exterior of the device), the WU binoculars, there appears to be a straight line extending on the upper surface of the binoculars between the eyepieces 14- there is no ergonomic indentation to accommodate the user's nose, thereby rendering the device uncomfortable for use in the upside-down position (the position asserted by the Examiner which must be used to anticipate the claims, according to the Examiner). One must thus assume that any ergonomic bend of the WU binoculars must be present in the bottom of the device (in relation to Fig. 1), which is not shown in any of the figures.

The Examiner has also determined that "the CCD sensor and the microphone are both in the input module as shown in Fig. 2 and both the CCD sensor and the microphone are in element 2 of Fig. 1" and has also determined that "there is no point of relation to limit which surface of the current binocular system is the bottom surface." In other words, the Examiner basically asserts that so long as WU discloses a binocular having a microphone, then it does not

¹ Appellants again note that this point was perhaps best illustrated by a quote attributable to Abraham Lincoln during the Lincoln-Douglas debates of 1858. Lincoln posited "How many legs does a dog have if you call the tail a leg?" His answer- "Four. Calling a tail a leg doesn't make it a leg."

matter where on WU the microphone may be mounted (including on the front surface of the storage unit 2, by the CCD lens 21). It appears that the Examiner has attempted to “bootstrap” the location of the microphone of WU to fit the outstanding rejection; however, the fact remains that WU completely fails to disclose the location of the microphone in relation to the binoculars. For example, paragraphs [0021] and [0022] of WU (identified by the Examiner) merely note that image/audio signal compression and storage parts are located in the digital storage unit 2, shown attached to the upper portion of the binoculars in Fig. 1. Appellants again note that neither the specification nor the drawings of WU discloses the claimed location of the microphone, and a proper rejection cannot be based on teachings in a reference that are vague or based on conjecture. See *Datascope Corp. v. SMEC, Inc.*, 776 F.2d 320, 227 USPQ 838 (Fed. Cir. 1985). It is again noted that it is well settled that an anticipation rejection cannot be predicated on an ambiguous reference. See *In re Turlay*, 304 F.2d 893, 134 USPQ 355 (CCPA 1962). Thus, Fig. 1 of WU does not show the claimed microphone on any face of the binoculars, much less on a bottom face of the binoculars, as required by the claims on appeal.

The Examiner also asserts that “there is no limitation on the WU device requiring the surface with the input module to be anything other than a bottom surface.” Appellants again note that since WU is silent as to the positional relationship of the binoculars of Fig. 1, and that there is no ergonomic bend to accommodate a user’s nose, the WU binocular is shown in Fig. 1 in its intended

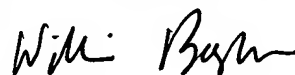
upright position (in relation to the user's face). As such, the microphone and input module 2 of WU are on the top (or upper) surface of the binoculars.

CONCLUSION

Appellants again respectfully submit that claims 1 and 3-6 are patentable under at least 35 U.S.C. § 102(e) over WU, claim 2 is patentable under at least 35 U.S.C. § 103(a) over any proper combination of the teachings of WU and HIRUNUMA, and claim 7 is patentable under at least 35 U.S.C. § 103(a) over any proper combination of the teachings of WU in view of NAGUMO. Specifically, the applied art of record fails to teach or suggest the unique combination of features recited in Appellants' claims 1-7 for at least the reasons noted *supra*. Accordingly, Appellants respectfully request that the Board reverse the decision of the Examiner to reject claims 1-7 and remand the application to the Examiner for withdrawal of the rejection.

Should the Examiner have any questions or comments regarding this paper, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

May 26, 2006
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